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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,798	11/13/2006	Karl-Heinz Wenzelburger	11601-33	4909
20311 7590 05/27/2010 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER HOWELL, DANIEL W				
ART UNIT		PAPER NUMBER		
3726				
NOTIFICATION DATE		DELIVERY MODE		
05/27/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

### Office Action Summary

**Application No.**

10/583,798

**Applicant(s)**

WENZELBURGER, KARL-HEINZ

**Examiner**

Daniel W. Howell

**Art Unit**

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-31 and 34 is/are rejected.
- 7) ☒ Claim(s) 32-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date 7-17-09, 6-21-06

1. The search report from the corresponding PCT has been reviewed, and the examiner will decline make any rejection based upon the references cited therein.
2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). For the examination of this application, the examiner has worked from the drawings of the priority document, but formal drawings are still needed for the application.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the conical shape of claim 28, the axial displacement of claim 29, and cover of claim 34 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The disclosure is objected to because of the following informalities: the pages of the specification need to be numbered sequentially.

Appropriate correction is required.

5. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The last full paragraph on page 3 of the specification states that the adjustment means may be arranged eccentrically to the axis of the boring head, but the specification give no guidance what that means, or how such an embodiment would appear.

6. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear in what manner the adjustment means is "arranged eccentrically" to the axis of the boring head means, or what the scope of this limitation is.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 17-20, 22-28, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzsimmons (3625624) in view of Perkins (2400839). Fitzsimmons shows cassettes 18' which are radially slidable in grooves 30' of housing 12'. A single adjustment piece 44 is placed at the axis of rotation, and the cartridges are placed against this piece 44 before screws 28' are tightened, such that both of the cartridges are placed at the desired radial location simultaneously. The piece 44 has a hole through which locking screw 52 extends along the axis of rotation. Each of the cartridges has a cutting insert 24'. As such Fitzsimmons lacks a guide element. Perkins shows a similar boring bar having cutter cartridge c1 and two guides i1, e1. Note that all of the cartridges are radially adjustable to desired locations. In view of Perkins teaching of providing guides i1, e1, it is considered to have been obvious to have embodied one of the cartridges of Fitzsimmons as a guide element in order to properly center the cutter along the axis of rotation, such that a hole of desired tolerances is made. Regarding claims 23-28, it is noted that the piece 44 is rectangular in cross section, with a central hole for screw 52. It is considered to have been obvious to have provided this piece 44 with other shapes, such as cylindrical or disk-shaped, as the piece 44 would still work the same regardless of the shape of its outer circumference.

9. Claims 28-29 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzsimmons '624 in view of Perkins '839 as applied to claim 17 above, and further in view of McClay (1797582). McClay shows a similar cutter having alternating cutting blades 17 and guides 16. The cutters are moved radially by an axially movable conical section 15, and the guides are moved radially by an axially movable conical section 13. It is considered to have been obvious to have provided Fitzsimmons with an axially movable conical piece as shown at

15 of McClay in order to simultaneously move the cartridges radially outward an equal amount. McClay also shows a cover 18 on the front of body 10. It is considered to have been obvious to have provided Fitzsimmons with a cover as shown by McClay in order to prevent debris from getting into the guide grooves for the cartridges.

10. Claims 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, David Bryant, may be reached at 571-272-4526.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3726 at the top of your cover sheet.

/Daniel W. Howell/  
Primary Examiner, Art Unit 3726